

REMARKS

Claims 1-9 were pending in the application at the time the Office Action was mailed. Claims 1-5 and 8 were rejected. Claims 6, 7, and 9 were objected to. Upon entry of this amendment, claim 1 will have been amended, no claims will have been canceled, and no new claims will have been added herein. Therefore, claims 1-9 remain pending in the application.

Information Disclosure Statement

According to the previous Office Action mailed January 11, 2007, the information disclosure statement (IDS) filed 1/5/04 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MMPEP §609 because the final listed reference is not a proper citation. A corrected IDS is herewith filed indicating the date (December 19, 2003) for the reference Open Access On-Line Breast Cancer Mutation Data Base, National Human Genome Research Institute. Applicants have not provided herein a copy of each page of this database, as the mutations discovered by Applicants are novel and were not listed in this database.

Telephonic Interview

Applicants thank the Examiner for the helpful telephonic interview on December 10, 2007. During the telephonic interview, the Examiner indicated that amending claim 1 to recite "(c) detecting the presence of a guanine at position 5217 of the *BRCA1* gene" would result in entry of this amendment and allowance of claims 1, 2, and 4-9.

Claim Objections

Claims 6, 7 and 9 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 1, from which claims 6, 7 and 9 depend, will have been amended herein to recite "(c) detecting the presence of a guanine at position 5217 of the *BRCA1* gene." Withdrawal of these objections is respectfully requested.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 3, 5 and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Panguluri et al. (Human Genetics (1999) 105:28-31; provided in IDS). Claim 1, from which claims 2, 3, 5 and 8 depend, will have been amended herein to recite "(c) detecting the presence of a guanine at position 5217 of the *BRCA1* gene." Withdrawal of this rejection is therefore respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Panguluri et al. in view of Livak et al. (U.S. Patent 5538848). According to the Office Action "[a]mendment of claim 1 to include a step (c) which recites detecting the presence of a guanine at position 5217 of the *BRCA1* gene would overcome the art rejections set forth in this office action." Claim 1, from which claim 8 depends, will have been amended herein to recite "(c) detecting the presence of a guanine at position 5217 of the *BRCA1* gene."

Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants have made every effort to present claims which overcome the Examiner's assertions, and it is believed that all claims are now in condition for allowance. No new matter has been added by virtue of this amendment. Applicants neither agree nor acquiesce in the rejections set forth in the Office Action or any previous Office Actions, and have amended the claims for the sole purpose of expediting prosecution of the application. If there are any remaining issues or the Examiner believes that a telephone conversation with the Applicants' attorney or agent would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at the telephone number shown below.

This response is being filed with a two month retroactive petition for extension of time and the appropriate fees. Although Applicants believe that no further extensions of time are required with submission of this paper, Applicants request that this submission also be considered as a petition for any further extensions of time if necessary. The Commissioner for Patents and Trademarks is hereby authorized to charge the amount due for any retroactive

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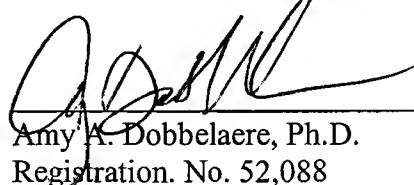
extensions of time and any deficiency in any fees due with the filing of this paper or credit any overpayment in any fees paid on the filing or during prosecution of this application to Deposit Account No. 50-0951.

Date:

4/7/08

Respectfully submitted,

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